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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,688	09/22/2003	Javier F. Delgado	MS302387.1/6001.268US01	9384
7590 Homer Knearl Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER KANG, INSUN	
			ART UNIT 2193	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/667,688

Applicant(s)

DELGADO ET AL.

Examiner

Insun Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004 and 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/29/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responding to application papers dated 1/6/2004 and 9/22/2003.
2. Claims 1-70 are pending in the application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 42-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 42-57 are non-statutory because they are directed to a "medium" and "product" that include a carrier/communication medium (i.e. carrier wave, signals such as electrical, electromagnetic etc) as recited in the instant specification (i.e. page 3 and 6). Such medium does not have a physical structure, rather it is the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism per se. Moreover, it does not fit within the definition of the categories of patentable subject matter set forth in § 101. Thus the claims represent non-functional descriptive material that is not capable of producing a useful result, and hence represent only abstract ideas. Therefore, the claims are non-statutory. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-23, 25-28, 30-40, and 42-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leovac (US Patent 6,668,375), in view of Hargrove et al. (US PG.Pub. 2003/0037325) hereafter Hargrove.

Per claim 1:

Leovac discloses:

- receiving a command from a user to install software on the computing device (i.e. "receiving from a user an indication of the option to be installed," col. 1 lines 50-51; "the customer first loads the installation module," col. 2 lines 62-67)
- accessing a storage medium having computer code necessary for installing a plurality of software products on the computer including the first software product (i.e. "installing a software option for a software application already installed on a customer computer system," col. 1 lines 40-45), the computer code including a first portion that is used during the operation of each of the plurality of software products after installation on the

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computer and a plurality of different second portions, each second portion associated with a different one of the plurality of software products and used during the operation of only its associated different one of the plurality of software products (i.e. The option is included on an installation medium provided for use with the customer system, which includes an installation module," col. 1 lines 40-55; "install a different set of options than the set of options already installed, " col. 2 lines 62-57).

Leovac does not explicitly teach the options available in the medium are a plurality of different software products. However, Hargrove teaches a multi-version software distribution medium was known in the pertinent art, at the time applicant's invention was made, to allow a user to install a different version conveniently (i.e. 0021). It would have been obvious for one having ordinary skill in the art to modify Leovac's disclosed system to incorporate the teachings of Hargrove. The modification would be obvious because one having ordinary skill in the art would be motivated to achieve a convenient software distribution for a user as suggested by Hargrove (i.e. 0021).

Leovac further discloses:

- determining that the user is entitled to install the first software product (i.e. "the customer a key to unlock the requested options," col. 3 lines 35-52)
- and installing on the computing device at least the first portion of computer code and only one second portion of computer code, that second portion being the second portion of computer code associated with the first software product (i.e. "If the keys match, the installation module unlocks the options requested...it copies the requested options from a file of options...on the installation medium," col. 3 lines 53-65).

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Per claim 2:

Hargrove further discloses:

- wherein each of the plurality of software products is a distinct version of a software application, each version having distinct runtime behaviors, or a distinct installation, or both(i.e. "a multi-version software distribution medium...multiple versions of installable software," 0039).

Per claim 3:

Leovac further discloses:

- receiving a command to execute an installer stored on the storage medium; and executing the installer (i.e. "installation module," col. 3 lines 53-65).

Per claim 4:

Leovac further discloses:

- receiving a command to execute an installer previously stored on the computing device; and executing the installer (i.e. "the set of options already installed," col. 2 lines 62-67).

Per claim 6:

Leovac further discloses:

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- requesting entitlement information from the user indicative of whether the user is entitled to install a software product; receiving the entitlement information; and validating the entitlement information(i.e. "a key to unlock the requested options," col. 3 lines 35-52).

Per claim 7:

Leovac further discloses:

- providing at least one lookup table in a file on the storage medium, the look up table associating each software product with information contained in packaging of the software product (i.e. "secure hash algorithm," col. 3 lines 35-52).

Per claim 8:

Leovac further discloses:

- copying only that computer code necessary to install the first software product from the storage medium to the computer(i.e. "If the keys match, the installation module unlocks the options requested," col. 3 lines 53-65).

Per claim 9:

Hargrove and Leovac further disclose:

-writing data to a registry maintained on the computing device, the data specific to the first software product(i.e. "copying files...value entries in registry keys," Hargrove, 0003; "operating systems allow the use of ...DLL," col. 2 lines 35-52; Fig. 2, Leovac) .

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Per claims 10, 12, 13, 17, and 18, they another method versions of the claimed method discussed in claims 1-9, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claim 11:

Hargrove further disclose:

-a plurality of data storage discs and wherein accessing further comprises: accessing at least two of the plurality of data storage discs (i.e. see Fig 2, plurality of discs)

Per claim 14:

Leovac further disclose:

- after input of the product key; decrypting the product key; and extracting information from the decrypted product key that identifies the first version (i.e. "If the keys match, the installation module unlocks the options requested," col. 3 lines 53-65).

Per claim 15:

Leovac further disclose:

- providing at least one lookup table in a file on the at least one data storage disc, the look up table identifying each product key with one of the plurality of versions on the at least one data storage disc(i.e. "secure hash algorithm," col. 3 lines 35-52).

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Per claim 16:

Leovac further disclose:

-validating a digital signature contained in the product key; and installing the first version only if the digital signature can be validated(i.e. "If the keys match, the installation module unlocks the options requested," col. 3 lines 53-65).

Per claims 19-22, they are another method versions of claims 1-18, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 1-18 above.

Per claim 16:

Leovac further disclose:

-packaging at least some of the storage media in packaging material having markings that indicate that the storage media in the packaging material contains only a first software product; and providing a different first product key with the packaging material of each of the at least some storage media, each first product key associated with the first software product indicated on the packaging (i.e. "If the keys match, the installation module unlocks the options requested...the requested options from a file of options...on the installation medium...onto the customer system as installed options...and it eliminates from the customer system any exclusions," col. 3 lines 53-65).

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Per claims 25, 27, and 28, they are another method versions of claims 1-18, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 1-18 above.

Per claim 26:

Hargrove further disclose:

-the lookup table identifies a distinct user interface to be displayed by each software product during runtime(i.e. "four different versions of the same general operating system," 0002).

Per claims 30-41, they are another method versions of claims 19-28, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 19-28 above.

Per claims 30-41, they are another method versions of claims 19-28, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 19-28 above.

Per claims 42-44 and 46-48, they are the medium versions of claims 1-28, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 1-28 above

Per claim 45:

Leovac further disclose:

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- a SKU table that associates each product key with a brand in a branding table and a map in a mapping table; the mapping table that associates each map with an end-user license agreement (EULA) identifier (i.e. It checks for consistency by referring to an orders database...using the system identification as an index, to determine the options," col. 3 lines 20-30; When the installation module...receives the key from customer service...it also computes a confirmatory key by hashing the same predetermined elements of the order alteration request, using the same predetermined hash algorithm...The installation module then compares the key it calculated...with the key it received," col. 3 lines 53-65; "a key maker 45 for computing a key based on elements of the system identification and the requested options communicated by the requester," col. 4 lines 2-22)

- the branding table that associates each brand with distinct text to be used during installation or runtime of the software product; and a EULA table associating each EULA identifier with a EULA (i.e. "When the installation module...receives the key from customer service...it also computes a confirmatory key by hashing the same predetermined elements of the order alteration request, using the same predetermined hash algorithm...The installation module then compares the key it calculated...with the key it received," col. 3 lines 53-65; "a key maker 45 for computing a key based on elements of the system identification and the requested options communicated by the requester," col. 4 lines 2-22).

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Per claims 49-57, they are the computer program product versions of claims 10-18, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 10-18 above.

Per claims 58-70, they are another method versions of claims 10-18 and 42-48, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 10-18 and 42-48 above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5, 24, 29, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leovac (US Patent 6,668,375), in view of Hargrove et al. (US PG.Pub. 2003/0037325) hereafter Hargrove, and further in view of Weisman (US pg.pub.2003/0028870).

Per claim 29:

Leovac and Hargrove do not explicitly teach transmitting identical copies of computer code necessary to install any of the plurality of software products to each consumer over a network for storage on the consumers' storage media. However, Weisman teaches distributing software over a network was known in the pertinent art, at the time

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applicant's invention was made, to provide a fast and convenient software distribution (i.e. "Software can also be distributed by making the software available for download over a network," 0006). It would have been obvious for one having ordinary skill in the art to modify Leovac and Hargrove's disclosed system to incorporate the teachings of Weisman. The modification would be obvious because one having ordinary skill in the art would be motivated to distribute software over network for fast delivery as suggested by Weisman (i.e. 0006; 0064).

Per claims 5, 24, and 41:

Leovac and Hargrove do not explicitly disclose a network installation having an installer on the server. However, Weisman discloses distributing software along with installer over a network was known in the pertinent art, at the time applicant's invention was made, to provide a fast and convenient software distribution (i.e. "Software can also be distributed by making the software available for download over a network," 0006; "downloads an installer 803 from the server computer," 0064). It would have been obvious for one having ordinary skill in the art to modify Leovac and Hargrove's disclosed system to incorporate the teachings of Weisman. The modification would be obvious because one having ordinary skill in the art would be motivated to distribute software over network for fast delivery as suggested by Weisman (i.e. 0006; 0064).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 571-272-3724.

The examiner can normally be reached on M-R 6:30-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MENG AI AN can be reached on 571-272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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